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10/689,432

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Julianne Bielski

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EXAMINER

RECEK, JASON D

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/689,432	<b>Applicant(s)</b> BIELSKI, JULIANNE	
	<b>Examiner</b> JASON RECEK	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 October 2003; 26 September 2006</u> .                      | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

This is in response to application 10/689432 filed on October 20<sup>th</sup> 2003 in which claims 1-21 are presented for examination.

### ***Status of Claims***

Claims 1-21 are pending, of which claims 1, 7, 12 and 17 are in independent form.

Claims 1-21 are rejected under 35 U.S.C. 102(e).

Claims 7-21 are rejected under 35 U.S.C. 101.

Claims 5, 11, 16 and 21 are rejected under 35 U.S.C. 112, second paragraph.

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the Specification does not provide proper antecedent basis for the term "computer usable medium" as recited in claim 12.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 7, it is directed towards a "system" however there are no hardware elements recited in the claim. Furthermore Applicant recites that a system may be in the form of software (Specification paragraph 27). In light of the claim and Applicant's disclosure, claim 7 is not directed towards one of the four categories of statutory subject matter. It is clearly not a process or composition of matter. It is not a machine or manufacture because no hardware elements are recited, in fact the Specification suggests that a system may be purely software. Software alone is per se non-statutory subject matter because it is merely functional descriptive material. To be a machine or manufacture, some sort of tangible hardware element must be recited. See MPEP 2601.01.

Regarding claims 8-11 they do not introduce any limitations that would make the claims cover statutory subject matter. Therefore they are also rejected since they depend from a rejected claim.

Regarding claim 12, it is directed towards a "computer program product, residing on a computer usable medium". The specification states that programs can be delivered via signals such as "signal-bearing media" and "communication media".

Signals are per se non-statutory. Since the claim includes signals it is directed towards non-statutory subject matter. See MPEP 2601.01.

Regarding claims 13-16 they do not introduce any limitations that would render the claims statutory (i.e. they do exclude signals or define a tangible storage medium), therefore they are also rejected since they depend from a rejected claim.

Regarding claim 17, it is directed towards a "service". A service is not one of the four categories of statutory subject matter under 35 U.S.C. 101. In light of the Specification (paragraph 27) a service could be software per se. Such software is merely functional descriptive material and is non-statutory unless it is embodied on some type of medium which renders it structurally and functionally related to the medium. See MPEP 2601.01.

Regarding claims 18-21, they do not introduce any limitations that would render the claims statutory, therefore they are also rejected since they depend from a rejected claim.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 11, 16 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, it recites "the sending of the request ... for an address... is automatically prompted by the remote computer receiving its IP address". The examiner understands this to mean that the remote computer will automatically request an address as soon as it receives an address. Thus the remote computer is in a constant loop of receiving an address, and then requesting another one. The claim is indefinite since the scope of the claim cannot be ascertained. It is unclear what happens if the remote computer does not receive an address. Also the word "prompted" is indefinite because it is not clear whether the request is sent without user interaction or whether a user is prompted to see if they want to send a request.

Regarding claims 11, 16 and 21, they are system, medium and service claims that correspond to the method of claim 5, thus they are rejected for similar reasons.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Komaki US 2006/0165056 A1.

Regarding claim 1, Komaki discloses “configuring in an address issuing computer Option data about a management computer” as a DHCP server with network setting information (paragraph 33), “an identification and authorization ... to request an address” as DHCP messages (paragraph 33), “a management computer address” as a server address that is part of network setting information (paragraph 33), “sending a request ... for an address” as terminal devices requesting an IP address (paragraph 33), “receiving ... the requested address ... and the Option data” as receiving network setting information (Option data) including IP addresses (paragraph 33), and “executing a local code in the remote computer ... to automatically provide the address of the remote computer to the management computer” as updating the IP address with the management server (paragraphs 40, 62).

Regarding claim 2, Komaki discloses “the management computer is a management server” as a management server (Fig. 1), and “the remote computer is a remote management processor” as terminal devices that have a processor (paragraph 29, Fig. 2a).



Regarding claim 3, Komaki discloses “a Dynamic Host Configuration Protocol (DHCP) server” (paragraph 27, Fig. 1).

Regarding claim 4, Komaki discloses “an Internet Protocol (IP) address” (paragraph 27).

Regarding claim 5, since it is currently indefinite, for prior art purposes this claim is being interpreted as if the remote computer sends a request for an IP address automatically, see the 112 rejection above. Komaki discloses this feature as automatically obtaining an IP address (paragraph 66).

Regarding claim 6, Komaki discloses “the local code directs the remote computer to automatically provide the address of the remote computer to the management computer in an ALERT packet” as the terminal automatically registers its IP address with the management server (paragraph 62), this communication would be sent in a packet since the devices are on a TCP/IP network (paragraph 27).

Regarding claims 7-11, they are system claims that correspond to the method claims 1-5 respectively, thus they are rejected for similar reasons.

Regarding claims 12-16, they are computer medium claims that correspond to the method claims 1-5 respectively, thus they are rejected for similar reasons.

Regarding claims 17-21, they are service claims that correspond to the method claims 1-5 respectively, thus they are rejected for similar reasons.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cromer et al. US 6,353,854 B1 discloses a remote computer sending configuration information automatically to a management computer (abstract).

Hanson et al. US 2003/0120811 discloses a process whereby a mobile end system and a DHCP server update a management server with the end system's network address (paragraph 287).

Doherty et al. US 2003/0018763 A1 discloses a DHCP server passing the address of a management server to a client (paragraph 6).

Stachura et al. US 7,318,089 B1 discloses an alert-enable client in communication with a management server (abstract).

Eguchi et al. US 2004/0073706 A1 discloses a system where addresses are transmitted to a management server once they are acquired (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Thurs 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Recek/  
Examiner, Art Unit 2142  
4/28/08

(571)-270-1975

/Andrew Caldwell/  
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